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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,920	07/09/2001	Robert J. Mos	01-SEM/108 DIV B	8617

22890 7590 06/21/2005

RICHARD D. CLARKE
LAW OFFICE OF RICHARD D. CLARKE
3755 AVOCADO BLVD., #1000
LA MESA, CA 91941-7301

EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,920

Applicant(s)

MOS ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

PD

DETAILED ACTION

1. This action is in response to communication filed on 10/03/2001. Claims 1 – 46 were received for consideration but were cancelled (see Remarks, "Total number of claims"). Preliminary amendments to the claims were filed on 07/09/2001, with new Claim 42 (please refer to claim objections).

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

3. Misnumbered new claim 42 has been renumbered Claim 47.

Correction of Inventorship

4. Examiner has contacted Pinchus Laufer with respect to removing Denise Jeffreys from the list of named inventors and requested Richard Clarke (6/2/2005) to file a corrected oath/declaration naming the two inventors, Robert Mos and Clay Von Mueller.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 47 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 43 and 46 of U.S. application serial number 09901846 (hereinafter "09/901846").

A partial correspondence between the 09/901846 claim and the instant claim is as follows:

Instant Claim

09/901846 Claim

47

43, 46

More specifically,

Per Claim 47:

This claim recites "a memory device having data encrypted with a signature derived from a series of arbitrary spatial relationships of spatially encoded data or inherent noise; a medium incorporating a spatially encoded memory device, fixed to the exterior of the chip card", which is recited in the Claim 46 of SN 09/0901846. Instant Claim 47 additionally recite, "a processing element to use the spatially encoded signature to access encrypted data in said memory device". Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 43 and 46 of copending Application 09/901846 falls entirely within the scope of claim 47 of the instant application. Specifically, it would have been obvious to one having ordinary skill in the art to recognize that 'a processing element' can be used to access encrypted data in memory device because the use of encoded encrypted signature implies a processing element to be used in order to access memory device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 47 recites the limitation "said memory device." in (c). There is insufficient antecedent basis for this limitation in the claim. Claim 47 in preamble recites, "a secondary spatially encoded memory device", (a) "a memory device having data ..." and (b) "a medium incorporating a spatially encoded memory device...". "... in said memory device..." does not clearly point out which "memory device". Examiner broadly interprets as either memory device.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Fernandez (U.S. Patent Number 5,616,904).

8. Regarding Claim 47, Fernandez teaches

(a) a memory device having data encrypted with a signature derived from a arbitrary spatial relationships of spatially encoded data or inherent noise (Summary and Column 5 line 31 – Column 6 line 3); and

(b) a medium incorporating a spatially encoded memory device, fixed to the exterior of the memory device, for storing the spatially encoded data (Summary and Column 5 line 31 – Column 6 line 3); and

(c) a processing element to use the spatially encoded encrypted signature to access encrypted data in said memory device (Column 5 line 53 – Column 6 line 25).

Conclusion

9. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on Tuesday – Thursday 8:00a.m. To 3:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy
June 07, 2005.


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100